

REMARKS/ARGUMENTS

Applicants respectfully submit, contemporaneously herewith, a Request for Continued Examination pursuant to 37 C.F.R. § 1.114.

Claims 1-11 are pending. Claims 1-11 have been rejected.

Claim Rejections 35 U.S.C. § 103(a)

Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being obvious over International Patent Application No. WO00/37579 to Arata et al. ("Arata '579") in view of Great Britain Patent No. 2 362 037 to Ongkosit ("Ongkosit '037") and further in view of Japanese Patent Application No. 2000-154232 to Ekusa et al. ("Ekusa '232"). For clarity, U.S. Patent No. 6,558,797 to Arata et al. ("Arata '797") will be cited herein, as it is an English equivalent of WO 00/37579.

In forming the rejection of independent Claim 1, the Examiner relies on Arata '579 as disclosing the halogenated epoxy resin, phenol novolac resin, and curing accelerator called for in independent Claim 1. However, the Examiner indicates that Arata '579 fails to disclose any of the other limitations called for in independent Claim 1. Thus, in forming the rejection of independent Claim 1, the Examiner relies on Ekusa '232 for teaching the use of an epoxy resin containing a mixture of a brominated epoxy resin and a non-brominated epoxy resin and contends that the addition of a non-brominated epoxy resin to the brominated epoxy resin used in the adhesive combination of Arata '797 would be obvious to a person of ordinary skill in the art.

In order to form a valid rejection under 35 U.S.C. § 103(a), the Examiner must identify in an Office Action a rational basis why a person of ordinary skill in the art would have combined or modified the prior art elements in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007) (a patent examiner must provide "an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate this review, this analysis should be made explicit."); *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR*) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.") It is not sufficient to merely show that the use of a brominated epoxy in combination with a

non-brominated epoxy is known in the art. The obviousness analysis is not complete until an explanation is provided as to why one having ordinary skill in the art would have been led to use the combination of a brominated epoxy and a non-brominated epoxy to form the epoxy resin used in the adhesive combination of Arata '579. See *Ex Parte Girouard et al*, Appeal No. 2007-3307 (Bd. Pat. App. & Int. 2008).

In the present case, the basis upon which a person of ordinary skill in the art would have combined or modified the prior art in the manner claimed by the Examiner is indicated to be "to use less solvent for environmental concerns." Office Action dated January 26, 2009, page 3. However, for the reasons described below, Applicants respectfully submit that one of ordinary skill in the art with no knowledge of the present invention would not modify the adhesive combination taught by Arata '579 by using a brominated epoxy in combination with a non-brominated epoxy as taught by Ekusa '232 in order to achieve the benefit of reducing the amount of solvent used.

Referring to the mechanical translation of Ekusa '232 provided by the Examiner, Ekusa '232 teaches a resin composition that includes five distinct components: (a) a brominated bisphenol A epoxy resin; (b) a bromination-free liquid bisphenol A epoxy resin; (c) a novolac-epoxy resin; (d) tetrabromobisphenol A, and (e) dicyandiamide. Ekusa '232, abstract. Ekusa '232 expressly teaches that dicyandiamide is "an essential ingredient", but has a "very bad" solubility and requires the use of a large volume of solvents. Ekusa '232, paragraphs [0003], [0006]. In order to reduce the amount of solvents used in conjunction with dicyandiamide, tetrabromobisphenol A is added to the resin composition of Ekusa '232. Specifically, paragraph [0007] of Ekusa '232 states, "If tetrabromobisphenol A is used instead of brominated epoxy resin, it will become possible to reduce the amount of the solvent used." Thus, in order to reduce the amount of solvents needed in conjunction with the use of dicyandiamide, Ekusa '232 teaches the addition of tetrabromobisphenol A.

Based on the teachings of Ekusa '232, it is the addition of tetrabromobisphenol A that results in a reduction in the use of solvents. Therefore, adding a non-brominated epoxy resin to the resin composition taught by Arata '579 would not result in a reduction in the use of solvents in the resin composition of Arata '579. As a result, the motivation cited by the Examiner is non-existent and there is no articulated reasoning with a rational underpinning to support the legal conclusion of obviousness. MPEP §2143.01(IV) (citing *KSR* and stating,

"Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness); see also *KSR*, 127 S.Ct. at 1740-41 (requiring an explicit analysis when a conclusion of obviousness is based on interrelated teachings of multiple patents, the effects of demands known to the design community are present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art).

Thus, for at least the foregoing reasons, Applicants respectfully submit that independent Claim 1, as well as Claims 2-10 which depend therefrom, are not obvious over Arata '579 in view of Ekusa '232 and further in view of Ongkosit '037.

Conclusion

It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically, Applicants respectfully submit that the application is in condition for allowance and respectfully requests allowance thereof.

In the event Applicants have overlooked the need for an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefor and authorize that any charges be made to Deposit Account No. 02-0385, Baker & Daniels.

[THIS SPACE INTENTIONALLY LEFT BLANK]

Application Serial No. 10/559,556
Amendment dated July 24, 2009
Reply to Final Office Action dated January 26, 2009

Should the Examiner have any further questions regarding any of the foregoing, the Examiner is respectfully invited to telephone the undersigned at 260-424-8000.

Respectfully submitted,



Matthew B. Skaggs
Registration No. 55,814

Attorney for Applicants

MBS/nw

BAKER & DANIELS LLP
111 East Wayne Street, Suite 800
Fort Wayne, IN 46802
Telephone: 260-424-8000
Facsimile: 260-460-1700

CERTIFICATION OF ELECTRONIC FILING

I hereby certify that this correspondence is being electronically filed with the United States Patent and Trademark Office on the date indicated below:

MATTHEW B. SKAGGS, REG. NO. 55,814

Name of Registered Representative



Signature

July 24, 2009

Date